

AO 120 (Rev. 08/10)

TO: Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been
filed in the U.S. District Court _____ for the District of Delaware _____ on the following

☒ Trademarks or ☐ Patents. (☐ the patent action involves 35 U.S.C. § 292.);

DOCKET NO. 16-661	DATE FILED 8/1/2016	U.S. DISTRICT COURT for the District of Delaware
PLAINTIFF DJP HOLDINGS, LLC, and DJP CONCEPTS IP SUB, LLC		DEFENDANT Donald J. Pliner; Lisa F. Pliner
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 U.S. Reg. No. 2,534	1/29/2002	DJP Concepts IP Sub, LLC
2 U.S. Reg. No. 1,991	8/6/1996	DJP Concepts IP Sub, LLC
3 U.S. Reg. No. 2,007	10/15/1996	DJP Concepts IP Sub, LLC
4		
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In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading		
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK	
1			
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT <i>Final Judgment and Permanent Injunction</i>
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CLERK <i>John A. Cerino</i>	(BY) DEPUTY CLERK	DATE <i>1-11-2017</i>
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Copy 1—Upon initiation of action, mail this copy to Director Copy 3—Upon termination of action, mail this copy to Director
Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

DJP HOLDINGS, LLC, and
DJP CONCEPTS IP SUB, LLC,

Plaintiffs,

v.

DONALD J. PLINER and LISA F. PLINER,

Defendants.

Civil Action No. 16-661-LPS

DONALD J. PLINER and LISA F. PLINER

Counterclaim-Plaintiffs,

v.

DJP HOLDINGS, LLC, and
DOES 1-20

Counterclaim-Defendants

**[PROPOSED]
FINAL JUDGMENT AND PERMANENT INJUNCTION**

Plaintiffs, DJP Holdings, LLC and DJP Concepts IP Sub, LLC (jointly, "Plaintiffs") and Defendants, Donald J. Pliner and Lisa F. Pliner (jointly, "Defendants," and together with the Plaintiffs, the "Parties" or individually, "Party"), having stipulated to the following final judgment and permanent injunction, and this Court having considered that stipulation and the pleadings and submissions in this action, final judgment is entered as follows:

IT IS HEREBY ORDERED, ADJUGED, AND DECREED THAT:

1. This Court has jurisdiction over this action and over the Parties.

2. For purposes of this Decree:
- a. **"NRAs"** means the Name Rights Agreement of February 14, 2011 between Donald J. Pliner and DJP Holdings, LLC and the Name Rights Agreement of February 16, 2011 between Lisa F. Pliner and DJP Holdings, LLC.
 - b. **"EAs"** means the Employment Agreement of February 16, 2011 between Donald J. Pliner and DJP Holdings, LLC and the Employment Agreement of February 16, 2011 between Lisa F. Pliner and DJP Holdings, LLC.
 - c. **"Restricted Branding"** means any of the following, alone or in combination:
 - (i) the Defendants' names DONALD J. PLINER, DONALD PLINER, LISA F. PLINER, LISA PLINER, and PLINER, or any abbreviated versions or variants of those names, including initials; (ii) the Defendants' likenesses, identities, or personae; (iii) the terms MOUNTAINS OF ITALY, BEACHES OF SPAIN, or any confusingly similar terms when used as a brand, mark, tag line, slogan, or other source identifier (provided that Defendants may state that their products are "Made in Italy" or "Made in Spain" if the statement is truthful and appears in a separate line from, and in a font size substantially smaller than, the brand name); and (iv) any mark confusingly similar to the mark shown in Plaintiffs' U.S. Registration No. 2,007,793.
 - d. **"Restricted Goods"** means any fashion or other lifestyle goods, including without limitation footwear and handbags.

- e. "RBS Co." means the Right Bank Shoe Company and/or any person acting on its behalf.
 - f. "**Promotional Communications**" means any advertising, marketing, or promotional communication, written or oral, in any medium, including without limitation all traditional forms of advertising; signage; brochures; point-of-sale or other in-store materials; television or radio commercials, infomercials, shopping channels, or other promotional content; website content, whether appearing on a website owned or controlled by Defendants or a third-party website (such as a pop-up ad); social media postings; press releases; paid-for or solicited media coverage; and promotional letters, notes, emails, or text messages to purchasers or prospective purchasers.
3. Defendants, and all those acting in active concert or participation with them, are hereby permanently enjoined from the use, within or outside the United States, of **Restricted Branding** (a) on any **Restricted Goods**; (b) on any labels, hang tags, or packaging for any **Restricted Goods**; (c) in any **Promotional Communications** for any **Restricted Goods**; (d) in any Internet domain names or metatags or in any e-mail or social media account user names, unless such e-mail or social media accounts are used solely for personal, noncommercial purposes; or (e) in any other way in connection with the manufacture, importation, shipment, fulfillment, advertising, promotion, sale, or offering for sale of any **Restricted Goods** bearing the **Restricted Branding**. Defendants are

hereby further permanently enjoined from conducting any promotional appearances in connection with any **Restricted Goods**.

4. Defendants, and all those acting in active concert or participation with them, are hereby permanently enjoined from registering or seeking to register as a trademark in any jurisdiction any mark consisting of or comprising any **Restricted Branding** for use on or in connection with any **Restricted Goods**, and from assigning, licensing or otherwise transferring or purporting to transfer any rights in any **Restricted Branding** to any other party.
5. Defendants, and all those acting in active concert or participation with them, shall immediately and permanently abandon, and take all necessary steps to withdraw with prejudice, U.S. Trademark Application Serial No. 87/010441 for FROM THE MOUNTAINS OF ITALY and Serial No. 87/010,454 for FROM THE BEACHES OF SPAIN.
6. Defendants, and all those acting in active concert or participation with them, shall immediately assign to Plaintiffs or permanently abandon all domain names consisting of or including **Restricted Branding**, and shall execute documentation affirming the completion of the forgoing assignment or abandonment of each such domain name.
7. Defendants, and all those acting in active concert or participation with them, are hereby permanently enjoined from the sale or offering for sale of any **Restricted Goods** that copy or imitate the distinctive designs, styles or trade dress of any products that currently

are, or have at any time in the past been, offered for sale by Plaintiff, DJP Holdings, LLC or its predecessors.

8. Defendants, and all those acting in active concert or participation with them, are hereby permanently enjoined from (i) any and all disclosure or use of any customer list belonging to Plaintiffs; (ii) any and all disclosure or use of any customer information contained in any customer list belonging to Plaintiffs, except to the extent such information duplicates information lawfully obtained from other sources; and (iii) any solicitation of any of the specialty or boutique customers included in the customer lists that were obtained by Stephen B. Jayne ("Mr. Jayne") and were addressed by the parties at the hearing of September 16, 2016 in this matter. It is acknowledged that the customers of DJP Holdings LLC and Defendants may by coincidence overlap and that fact alone shall not constitute a violation of this paragraph 8 or any other provision of this Order, but may be used by Plaintiffs as circumstantial evidence that such a violation has occurred.
9. Defendants, and all those acting in active concert or participation with them, shall immediately and permanently destroy or cause to be destroyed any client lists, documentation of or materials embodying trade secrets, or other confidential information obtained from Mr. Jayne or otherwise obtained from or belonging to the Plaintiffs, and shall provide written certification of their good-faith efforts to obtain the destruction of all such information in the possession of Mr. Jayne. Defendants represent and warrant that Defendants no longer employ, and do not intend to employ, Mr. Jayne; that RBS Co.

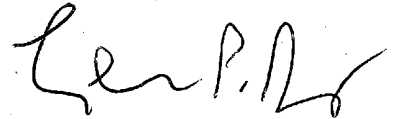
does not employ, and does not intend to employ, Mr. Jayne; and that Defendants and RBS Co. do not control Mr. Jayne or his activities and cannot certify his conduct to Plaintiffs or to the Court; notwithstanding the foregoing, Defendants are informed and believe that Mr. Jayne has destroyed all copies of Plaintiffs' customer list previously in his possession.

10. Defendants, and all those acting in active concert or participation with them, shall immediately and permanently destroy or cause to be destroyed any products, packaging, models or prototypes, and advertising or marketing materials that do not comply with the terms of this Order.
11. Defendants, and all those acting in active concert or participation with them, are hereby permanently enjoined from (i) referring to Plaintiffs or Plaintiffs' products (regardless whether that reference consists of or includes text and/or images) in a manner that is false, misleading, confusing, or disparaging; (ii) stating or implying that Defendant Donald J. Pliner is the "real" or "official" Donald J. Pliner (or other similar characterizations) or that Defendants' products are the "real" or "official" Donald J. Pliner brand products (or other similar characterizations); and (iii) using any purported disclaimers of affiliation with Plaintiffs or Plaintiffs' products except as may be contemplated in the **NRAs** or otherwise authorized by Plaintiffs.
12. Defendants, and all those acting in active concert or participation with them, are hereby permanently enjoined from any acts or omissions that would constitute any other breach of their **NRAs** or of any surviving obligations of their **EAs** not otherwise specified above.

This Decree is not intended to limit the “Permitted Activities” granted to Defendants, respectively, under § 2 of the **NRAs**, including, without limitation, the right to use their names, signatures, voices, images, likenesses, biographies, personal histories and personal names and variations thereof in the field of Permitted Activities (defined in the **NRAs**).

13. Defendants shall take all legal and necessary actions to ensure that all those acting in active concert or participation with them, as well as any entity that they own or control, or with whom they contract, are employed by, or otherwise are affiliated, will comply with all of the terms this Order.
14. The provisions of this Order are not intended to bar or restrict Defendants from competing in the fashion footwear industry, including through RBS Co. or another entity, in a manner that does not violate the terms of this Order, their **NRAs**, or any surviving obligations of their **EAs**.
15. This Order resolves all disputes, claims, and counterclaims between the Parties with respect to the matters referred to herein. No waiver, modification, or amendment of any provision of this Order shall be effective unless made in writing, agreed to by the Parties and entered as an Order of this Court.
16. Final judgment is hereby entered in Plaintiffs’ favor on Counts I, III, VIII, and IX of the Complaint and dismissing with prejudice the remaining counts of the Complaint and all counts of Defendants’ Counterclaims.

17. This Court shall maintain continuing jurisdiction of this action and over the Parties thereto for the purpose of enforcing or modifying this Order, and for the purpose of granting such additional relief as may be necessary or appropriate.



The Honorable Leonard P. Stark
United States District Judge

January 11, 2017